

REMARKS

The Examiner has disapproved the proposed drawing correction and substitute sheets of drawings as allegedly introducing new matter. Specifically, the Examiner cites five areas in which new matter was allegedly introduced. None of the five areas cited are of any significant relevance to the claimed invention. Two of the five areas cited (a and c) merely refer to the relative sizes of several of the elements of the invention. Nowhere in 37 CFR or MPEP § 608.02 is there a requirement that drawings must be to scale; that is, various elements may be larger or smaller than they actually are in relation to each other. Moreover, it is very clear to one of ordinary skill in the art that the drawings as originally filed were informal and certainly not to scale. No aspect of the objected to portions of the drawings are found in the claims and therefore there is no new matter.

The second area of objection is that fold-over flaps 36 and 38 are shown as “attached to panel 30, and this is not shown in the original drawings.” Applicant respectfully submits that flaps 36 and 38 are shown in the original drawings in schematic form and are thus not limited to being attached exclusively to either pocket 18, 20 or panel 30, since the drawings were informal. Moreover, owing to the very very slight overlap of flaps 36 and 38 in the respective upper right corners of pockets 18 and 20, Applicant contends that the original drawings do in fact support a reading that the fold over flaps are attached to panel 30. To one of ordinary skill, the drawings, originally informal, are correctly understood by the formal drawings. Again, no new matter has been introduced.

The fourth objection is that “there is only one hinge line 41 in the original drawing.” Applicant respectfully submits that element 41 is a hinged edge made of a plastic material as described in the specification (see, e.g., page 5, lines 11-14). As such, and because nothing in the universe is foldable to a perfect one-dimensional line, hinged edge 41 has some thickness and some curvature to it, as one of ordinary skill in the art would understand. The single “hinge line 41” shown in the original drawings is a schematic approximation of such a hinge; the two lines shown in the formal drawings are a more accurate representation of what the hinge would look

like.

The fifth alleged addition is that “handles 16 are attached to the outside of the bag in the original drawings.” This statement is not entirely accurate. The handles are shown as attached to the outside of the bag in original Figs. 1 and 2 but to the inside of the bag in original Fig. 3. Moreover, Claim 1 as originally written and submitted recites “an over the shoulder-size handle secured to a first of said panels....” Similar language is present in originally-filed Claim 16. The claims of the application are certainly a part of the application upon which antecedent basis may be based. By the use of the simple wording “to” instead of “to an inner/outer side of”, Applicant taught that one could secure the handles to either the inside or the outside (or even directly to the edge) of the panels. Incidentally, since placement of the handles are never an issue with the claimed invention, the specification, or in relation to the prior art, it is unclear why it matters at all where the handles are physically attached to the panels. No new matter has been introduced, since the original drawings are understood by those of skill in the art to cover either embodiment.

Applicant refers the Examiner to 37 CFR § 1.81, which describes the purpose of drawings in a utility application:

- (a) The applicant for a patent is required to furnish a drawing of his or her invention where necessary for the understanding of the subject matter sought to be patented; this drawing, or a high quality copy thereof, must be filed with the application. [...]
- (b) Drawings may include illustrations which facilitate an understanding of the invention (for example, flow sheets in cases of processes, and diagrammatic views).

The remaining requirements under §§ 1.83-84 pertain to matters like line quality and margins, all of which conditions the submitted formal drawings satisfy. Applicant respectfully submits that the submitted formal drawings fulfill the statutory purpose of patent drawings and do not add new matter to the application. An example of new matter would be the addition of an umbrella to the bag and a claim to a combination of a bag and umbrella. As has been long the law, “[i]n a sense, anything inserted in a specification that was not there before is new to the specification is

new to the specification but that does not necessarily mean it is prohibited as 'new matter.'" *In re Oda*, 170 USPQ 268, 270 (CCPA 1971). Slightly changing the size of one element with respect to another is not new matter for utility patent application drawings, particularly when the originally submitted drawings are informal. The claims do not recite the relative sizes of these elements, and the original drawings are understood by one of skill in the art to encompass various sizes and size relationships of the elements. Accordingly, it is respectfully submitted that the formal drawings submitted do not add new matter and should be accepted.

The Examiner has renewed the objection concerning the "lined plastic" (i.e., plastic liner material) of Claim 11. This objection is respectfully traversed. In Fig.2, slit 32 clearly shows plastic disposed therebehind (the crosshatching within the rectangle of slit 32). When the formal drawings are accepted, this objection will be moot.

Turning to more substantive matters, the Examiner has again rejected all of the claims of the instant application. Specifically, Claims 1, 2, 4-11, and 13-18 were rejected under 35 USC § 103(a) as anticipated by Medow in view of Manning. The remaining claims were rejected as obvious under §103(a) in view of a variety of prior patents. Applicant respectfully traverses these rejections and has amended the independent claims to place the application in better form for further examination and, it is believed, in condition for allowance.

The cited prior art fails to teach or suggest this invention. Medow shows an activity tote having two hinged halves which meet together to form an enclosure. There is neither a teaching nor a suggestion of utilizing Velcro along the lateral edges for completely enclosing the sides of the pocketbook. Applicant's invention contemplates two panels which are hingedly connected together with the side edges of the panels being provided with Velcro for sealing the edges thereof. Then, with at least one oversized handle for allowing the bag to be placed over a shoulder, the same hand of the shoulder can be used to open the a bag. This is not taught nor suggested by the Medow reference. The use of Velcro along substantially all of the perimeter of the side panels allows the bag to be incrementally opened, i.e., a little bit, half way, all the way, or any degree in between as desired by the user. By contrast, Medow shows the use of Velcro

only at the top edges and thus the bag is either fully closed or open. Patentable subject matter exists in this aspect of the claimed invention.

The Manning reference does not make up for the deficiencies in Medow. Specifically, Manning teaches a mat that is collapsible into a bag-like structure. Manning is not even classified in the same art as Medow or the instant application. One skilled in the bag art –specifically in the area of diaper bags– would not look to Manning at all to modify Medow. There must be a reason or suggestion in the art for combining the references, other than the knowledge obtained from Applicants' disclosure. *In re Dow Chemical*, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988) (citing *Interconnect Planning Corporation v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985)), *ACS Hospital Systems v. Montefiore Hospital*, 221 USPQ 929, 932 (Fed. Cir. 1984). The mere fact that the prior art could be so modified does not make the modification obvious unless the prior art itself suggests the desirability of the modification. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984). The Federal Circuit has, on numerous occasions made this point clear. For example, the court stated in *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929 (Fed. Cir. 1984) that:

obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under § 103, teachings of references can be combined only if there is some suggestion or incentive to do so.

ACS Hospital Systems, at 932-933.

Here, the Examiner has failed to show how one would be motivated to combine the teachings of the Manning patent to an unrelated Medow patent other than by reading Applicant's application, and thus the Examiner has failed to meet his burden of establishing a *prima facie* case for obviousness. Even with the proposed combination, there is no teaching of Velcro fastening along the entire edges of the panels to allow for incremental opening or closing of the device while wearing the device over one's shoulder. It is true that Manning shows Velcro running along the sides of the interior of the mat, however there is no reason why anyone would

need incremental access to the interior of the Manning device, since it is primarily a cushion and in no way wearable as a pocketbook.

The remaining prior art is equally deficient in teaching or suggesting a diaper bag that can be worn over a shoulder and simultaneously opened with but a single hand. Not any one of the references teaches or suggests enabling the user to open the bag with one hand by pulling down on a panel while still wearing the bag to access the pockets disposed on the interior of the bag.

Applicant has hereinabove amended the claims to point out the distinctions between the invention and the cited art.

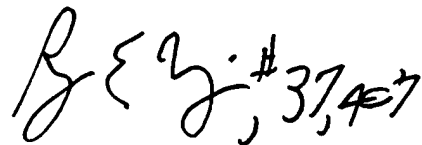
In view of the foregoing, Claims 1-3 and 5-18 are believed to recite patentable subject matter, and this application is believed to be in a condition of allowance. The prior art of record neither teaches nor suggests the invention, either when the various references are taken alone or in combination. **The Examiner is invited to telephone the undersigned to discuss any further changes that might be deemed necessary.** Prompt and favorable action toward the issuance of a patent is earnestly solicited and believed to be fully warranted.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any additional required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. **02-2105**.

Respectfully submitted,

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I certify that this document and fee are being deposited with the U.S. Postal Service as Express Mail addressed to Commissioner for Patents, Washington, DC 20231, Express Mail Label No. EV124966590.

Barry E. Negrin
Mailing Date: April 14, 2003